

Applicants : Samuel J. Danishefsky and Bishan Zhou
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REMARKS

Claims 1-17, 33-49, 84-91 and 121 were pending in the subject application. By this Amendment, applicants have amended claims 1, 2, 3, 33, 34, 35, 84, 85, 86, and 121. Therefore, claims 1-17, 33-49, 84-91 and 121 are currently pending in this application.

Support for the amendment to claim 1 may be found, *inter alia*, in the specification, as originally filed, on page 3, lines 19-33, on page 10, lines 2 and 20-23 and on page 24, line 24.

Support for the amendment to claim 2 may be found, *inter alia*, in the specification, as originally filed, on page 9, line 16.

Support for the amendment to claim 3 may be found, *inter alia*, in the specification, as originally filed, on page 9, line 35.

Support for the amendment to claim 33, may be found, *inter alia*, in the specification, as originally filed, on page 10, line 2, on page 15, lines 3-6, on page 24, line 24, on page 38, compounds 46 and 49, on page 40, compound 63 and on page 42, compound 81.

Support for the amendment to claim 34, may be found, *inter alia*, in the specification, as originally filed, on page 13, line 26.

Support for the amendment to claim 35, may be found, *inter alia*, in the specification, as originally filed, on page 14, line 18.

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Support for the amendment to claim 84, may be found, *inter alia*, in the specification, as originally filed, on page 10, lines 20-23, on page 39, compounds 47, 48 and 55 and on page 55, compound 107.

Support for the amendment to claim 85, may be found, *inter alia*, in the specification, as originally filed, on page 25, lines 24-25.

Support for the amendment to claim 86, may be found, *inter alia*, in the specification, as originally filed, on page 26, lines 20-21.

Support for the amendment to claim 121, may be found, *inter alia*, in the specification, as originally filed, on page 24, lines 19-34 and on page 55, compounds 104 and 107.

Rejection under 35 U.S.C. § 112, first paragraph

On pages 2 of the November 23, 2004 Office Action, the Examiner rejected claims 1-4, 12, 14-17, 33-36, 44, 46-49, 84-86, 88 and 121 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement.

The Examiner alleged that claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner acknowledged that the claims have been amended in response to the 112 rejections of the previous action. However, the Examiner

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alleged that R_2 as $OC(O)C_1-C_6$ is not seen to be described as an example of an acyloxy group. The Examiner further alleged that R_6 as $OC(O)C_1-C_3$ lacks descriptive support in the disclosure as originally filed. The Examiner concluded that changing these variables to recite $OC(O)C_1-C_4$ consistent with parent would not be objected to.

The Examiner acknowledged that the remaining 112 rejections of the previous action have been overcome by applicants' amendments.

In response to and without conceding the correctness of the Examiner's comments, the applicants have amended claims 1-3, 33-35, 84-86, and 121 to recite " R_2 is ... $OC(O)(C_1-C_4$ alkyl)...". Claims 4, 12, 14-17, 36, 44, 46-49 and 88 have incorporated this amendment by virtue of their dependence on the amended claims. Applicants have also amended claims 1-3 to recite " R_6 is ... $OC(O)(C_1-C_4$ alkyl)...". Therefore, applicants request that the Examiner withdraw the rejection of claims 1-4, 12, 14-17, 33-36, 44, 46-49, 84-86, 88 and 121 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement.

Rejection under 35 U.S.C. § 102

On page 3 of the November 23, 2004 Office Action, the Examiner maintained the previous rejection of claims 1-4 and 84-86 under 35 U.S.C. § 102(b) as allegedly anticipated by Zhou, et al., Tetrahedron Lett. 2000, 41, 2043-2046 ("Zhou"). The Examiner stated that the applicants urged that they are entitled to benefit of US provisional filing date making Zhou not a competent reference. However, the Examiner alleged that

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the claims rejected herein are only accrded the instant filing date in view of lack of compliance with 35 USC 112 first paragraph for reasons given above. The Examiner acknowledged that claims 5 and 8 are free of the 112 rejection made and are otherwise described in the US provisional case.

The Examiner stated that the previous rejection over Myers is withdrawn in view of the amendments made.

The Examiner also objected to Claims 5-11, 13, 37-43, 45, 87, 89-91 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In response, as noted above, applicants have amended claims 1-4 and 84-86 to be in compliance with 35 U.S.C. 112, first paragraph. Therefore, applicants request that the Examiner withdraw the rejection of claims 1-4 and 84-86 under 35 U.S.C. § 102(b) based on Zhou.

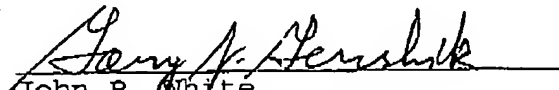
Moreover, applicants request that the Examiner reconsider and withdraw the objection to claims 5-11, 13, 37-43, 87, and 89-91 as these claims are dependent on claims that, as amended, are free from rejection.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

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No fee is deemed necessary in connection with the filing of this Amendment. However, if any fee is deemed necessary, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,


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